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WARF-0002

Allen S. Laughon

09/810,385

March 16, 2001

REMARKS

Claims 1-8 are pending in this application. In view of the Examiner's withdrawal from consideration of claims 5-8, claims 5-8 have been canceled. Applicant retains the right to pursue claims directed to the subject matter of canceled claims in a continuing application. Claims 1-4 of the present application have been subjected to a Restriction Requirement under 35 U.S.C. §121 as follows:

The Examiner suggests that claim 1 is generic to a plurality of disclosed patentably distinct species comprising multiple SMAD proteins. Applicant is required to elect a single disclosed species. Further, the Examiner suggests that claim 1 is generic to a plurality of disclosed patentably distinct species comprising multiple SMAD protein co-repressors. Applicant is required to elect a single disclosed species.

Specifically, the Examiner suggests that this application contains claims directed to the following species of the claimed invention (relating to signaling ligands): TGF- β , Activin, and Bone morphogenetic protein. Applicant is required under 35 U.S.C. §121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

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The Examiner further suggests that this application contains claims directed to the following species of the claimed invention (relating to co-repressors): Evi-1; TGIF; SIP1; and Schnurri. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

The Examiner further suggests that this application contains claims directed to the following species of the claimed invention (relating to Smad): Drosophila MAD; and Medea. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

The Examiner further suggests that this application contains claims directed to the following species of the claimed invention (relating to CtBP proteins): dCtBP; CtBP2; and any homologue of CtBP. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. The Examiner has acknowledged that claim 1 is generic. Applicant respectfully traverses this restriction requirement.

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MPEP 803 is quite clear; for a proper restriction requirement, it must be shown (1) that the inventions are independent or distinct AND (2) that there would be a serious burden on the Examiner if the restriction is not required. MPEP 802.01 defines "distinct" to mean that the "two or more subjects as disclosed are related, for example, as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made there, etc., but are capable of separate manufacture, use, or sale, as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER."

As acknowledged by the Examiner, generic Claim 1 (and its dependent claims 2-4) is a method for identifying compounds that directly interact with a Smad protein. Thus, Applicant respectfully disagrees with the Examiner's suggestion that in the event no generic claims is found to be allowable, the various species identified are distinct as being novel and unobvious over each other as required by MPEP 802.01. Accordingly, reconsideration and withdrawal of the election requirement of the claims is respectfully requested.

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However, in an earnest effort to be completely responsive and facilitate prosecution of this application, Applicant hereby elects to prosecute: (a) the Smad: *Drosophila* Mad; (b) The Smad co-repressor: Schnurri; (c) the CtBP protein: dCtBP and (d) the repressor of transcription (signaling ligand): bone morphogenetic protein, with traverse.

Respectfully submitted,

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